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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/689,721	08/12/96	PERRY	A

MM51/1130

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EXAMINER
LUEBKE, R

ART UNIT	PAPER NUMBER
2832	23

DATE MAILED: 11/30/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/689,721	Applicant(s) Perry
	Examiner Renee S. Luebke	Group Art Unit 2832

☒ Responsive to communication(s) filed on *Oct 29, 1998* .

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *6* is/are pending in the application.

Of the above, claim(s) *none* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *6* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. The request filed on October 29, 1998 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/689721 is acceptable and a CPA has been established. An action on the CPA follows.

2. The substitute specification filed October 29, 1998 has not been entered because it does not conform to 37 CFR 1.121(a) or 1.125. Contrary to applicant's remarks, the SECOND MARKED-UP COPY shows that the substitute specification and abstract are not amended versions of the documents presently of record. For example, title "BACKGROUND OF THE INVENTION" is already present in the specification of June 2, 1997. Other deviations are too numerous to list. In addition, the examiner did not require a substitute specification. Therefore, the specification and abstract of October 29, 1998 have not been entered.

The abstract as filed on August 6, 1996 and the substitute specification as filed on June 2, 1997 are still presently of record and are considered below.

3. The substitute specification, filed June 2, 1997, remains objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure includes the following:

a. The requirement that the ring be "a few thousandths of an inch larger" than the recorder. This was not shown since the original drawings did not clearly show the relationship between the inside of the ring and the recorder. If anything, it appeared to show that they were essentially the same size. The measurement of "a few thousandths" certainly could not have been determined.

b. The use of a "thin cloth material" for the strap was not disclosed. Whether or not a particular material or structure "is a well known equivalent" is irrelevant to the issue of new matter.

c. The use of a "simple over-hand" knot was not originally disclosed. The original drawings were not sufficiently clear to discern the type of knot used and the specification was silent on this issue.

d. The suggestion that the principle may be "extended to applications involving other musical instruments or objects" was not originally presented.

Applicant is required to cancel the new matter in the response to this Office action.

It is again noted that the original specification, filed August 12, 1996, contained no information about materials, dimensions or methods of use and assembly. It is this original disclosure from which the designation of new matter is made. Applicant argues that "a method is fully described in the specification as it stands prior to this amendment." The examiner is unsure to which amendment the applicant is referring. However, as previously noted, the original specification did not include sufficient details to support the present method claims. The supplemental amendment of June 2, 1997 which is presently of record was allowed entry, with the indication that it contained much new matter that must be deleted, in order to help progress prosecution of the application which was being handled pro se. As all successive amendments have been part of CPA filings, the determination of new matter must be made from the original specification.

4. Claim 6 remains rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In particular, the original specification did not contain information concerning the method of using the device.

Applicant argues that 35 U.S.C. 112 addresses the specification and not the claims. However, as indicated in section 608.04, "the claims affected are rejected under 35 U.S.C. 112, first paragraph." Applicant is further referred to MPEP 706.03(o).

5. Claim 6 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the claims is indefinite because there is an inconsistency throughout the claim. The claim initially indicates that the subcombination, a method for suspending a recorder, is being claimed. However, the claim also contains positive limitations directed

toward the recorder, suggesting that applicant intends to claim the combination of the recorder and its suspension method. Although applicant has stated that the claim is drawn to a method, the language of the claim must be amended to be consistent with this intent.

The claim contains both a product (specific limitations drawn to the recorder and the suspension device) and the process of using and, therefore, is seen to be indefinite. As noted in MPEP §2173.05(p), a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph. Applicant argues that this precedent is inappropriate because the claim does not begin by stating "a recorder *and* a method of using same." However, applicant has improperly attempted to claim the recorder and the method without this statement. To meet the claim requires meeting limitations to the structure of the recorder and to the method of suspending same. The precedent and rejection are appropriate.

6. Claim 6 remains rejected under 35 U.S.C. 101 because the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. Contrary to applicant's statements, the claim still contains both apparatus and method limitations.

7. This is a CPA of applicant's earlier application. All claims are drawn to the same invention claimed earlier and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered earlier. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP §706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. **It is suggested that responses to this final action be faxed to:**
(703) 308-7722, 308-7724 or 308-7382
This facsimile transmission service for formal amendments is provided as part of Technology Center 2800's After Final program to improve communication with our customers. Use of this program reduces processing time, will result in more timely responses by the Office and should result in fewer requests for extensions of time. Please refrain form sending a confirmation copy, as noted in 37 CFR 1.6(d) and 1.8(b).

For formal communications, please mark "EXPEDITED PROCEDURE"
For informal or draft communications please clearly label "PROPOSED" or "DRAFT"

Alternatively, responses may be mailed to:
Box AF
Assistant Commissioner for Patents
Washington, DC 20231

Hand-delivered responses should be brought to:
Crystal Plaza 4, Fourth Floor (Receptionist)
2201 South Clark Place, Arlington, Virginia.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mrs. Renee Luebke at (703) 308-1511. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Gellner, can be reached at (703) 308-1721.

Renee S. Luebke
Primary Patent Examiner
November 24, 1998